

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed October 30, 2008. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-4, 6-18, and 20 were rejected. Claims 5 and 19 were objected to. Claims 1-3, 9, 10, 16-18, and 20 have been amended to further define various features of Applicant's invention. Claim 11 has been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Drawing Objections**

The Examiner objected to the drawings, because they must show every feature of the invention specified in the claims. Applicant has cancelled Claim 11 and respectfully requests the objections be withdrawn.

#### **Claim Objections**

The Examiner objected to Claims 1-3, 9-11, 16-18, and 20 because of informalities. Applicant has amended Claims 1-3, 9, 10, 16-18, and 20 as requested by the Examiner and respectfully requests the objections be withdrawn.

#### **Rejections under 35 U.S.C. § 102**

Claims 1-4, 11, and 15-18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,657,122 issued to Hans-Joachim Krenzer et al. ("Krenzer"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir.

1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner considers that *Krenzer* discloses all limitations of claim 1. Applicant respectfully disagrees, because claim 1 requires that the inner layer surrounds the conductor so as to cover it completely. The single layer, coated or not, disclosed by *Krenzer*, with perforations or holes does not surround the conductor so as to cover it completely.

*Krenzer* discloses a single layer or tape 8 that has a plurality of perforations or holes 9. *Krenzer*, column 2, lines 39-42. The tape 8 is applied to conductors and the tape may be coated. The perforations or holes 9 ensure that the cooling liquid has access to the conductors. *Krenzer*, column 2, lines 46-49. An inner layer surrounding the conductor so as to cover it completely is not present in *Krenzer*, because the cooling liquid has access to the conductors through the perforations or holes.

Since *Krenzer* fails to disclose that an inner layer surrounds the conductor so as to cover it completely, it is respectfully requested that the rejection under 35 U.S.C. §102 is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102, if necessary.

### **Rejections under 35 U.S.C. §103**

Claims 1, 6, 7, 16, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication WO1995/30991 filed by Paul Perger et al. (“Perger”) in view of U.S. Patent Publication 2002/0029897 filed by A. Karim Younsi et al. (“Younsi”). Applicant respectfully traverses and submits the cited art combinations, even if proper, which

Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 8-10 and 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Krenzer*. Applicant respectfully traverses and submits that *Krenzer* does not render 8-10 and 12-14 obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Examiner considers that *Perger* can be modified with *Younsi* and that this would render the independent claims obvious. The Applicant respectfully disagrees, because *Perger* discloses to use only one woven strip layer to hold the conductors and *Younsi* teaches to use at least two solid layers of differing permittivity to create a more advantageous stress distribution within the dielectric.

*Perger* discloses to use only one woven strip layer to hold the conductors. *Perger*, page 3, lines 26-29. As explained in the abstract, the woven strip layer allows the cooling cross-section between the individual turns to be kept constant and increases tear resistance.

The use of a second, inner or outer, layer is not disclosed. This is naturally so, because this would not allow the cooling cross-section between the individual turns to be kept constant and increase tear resistance during the winding of such a second layer. One having ordinary skill in the art would therefore not consider a second, inner or outer, layer. In fact, *Perger* teaches therefore away from the claimed invention.

*Younsi* teaches to use at least two solid layers of differing permittivity to create a more advantageous stress distribution within the dielectric. *Younsi*, [0001]. Here the conductor bundle is wound with several layers of tape, each having a predetermined thickness and different permittivity. *Younsi*, [0026]. Since *Younsi* teaches that this must be done to create a more advantageous stress distribution within the dielectric, one having ordinary skill in the art would not consider a layer of woven strip. In other words, using a woven strip layer would not result in a graded increase in the electric field as taught by paragraph [0006] in *Younsi*. In fact, also *Younsi* teaches therefore away from the claimed invention.

The Examiner considers that one having ordinary skill in the art would look to *Younsi* because of protecting a conductor from the environment. The Applicant respectfully disagrees, because *Younsi* teaches to use at least two solid layers of differing permittivity for the purpose of creating a more advantageous stress distribution within the dielectric, rather than protecting a conductor from the environment. *Younsi*, [0001].

Turning to the obvious rejection based on *Krenzer*, it is noted that *Krenzer*, as explained above, teaches to allow the cooling liquid to access the conductor bundle. Therefore, any combination with *Krenzer* would result in one having ordinary skill in the art allowing such access of cooling liquid to the conductor bundle.

Since the cited prior art fails to teach or suggest all limitations of the independent claims, it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

**Allowable Subject Matter**

Applicant appreciates Examiner's consideration and indication that Claims 5 and 19 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. However, the amended independent claims appear to be in condition for allowance and Applicant requests therefore favorable action.

**CONCLUSION**

Applicant has now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of Claims 1 to 10 and 12 to 20 as amended.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicant

A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized, flowing script.

Andreas Grubert  
Reg. No. 59,143

Date: January 28, 2009

**SEND CORRESPONDENCE TO:**

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